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Examiner Interview

Applicant's counsel and Examiner Miller discussed the information disclosure statement. A corrected copy of the information disclosure statement is attached.

Remarks

Claims 1 through 12 remain pending in the application.

The Office Action states that the information disclosure statement filed September 16, 2003 fails to comply with 37 C.F.R. §1.98(a)(2). Pursuant to the interview, Applicant has provided a corrected information disclosure statement with this response.

The Office Action states that claims 1 through 5 and 7 through 11 are rejected as claiming the same invention as claims 1 through 3, 9 and 10 of Bitton, Bubble Wand with Ornaments within a Container, U.S. Patent 6,620,017 (Sep. 16, 2003).

Contrary to the Office Action statement, Applicant claims inventions different from those claimed in Bitton '017. The test to determine whether a claimed invention is different than a previously claimed invention is, "whether one of the claims could be literally infringed without literally infringing the other." In re Vogel, 422 F.2d 438, 441 (C.C.P.A. 1970) (cited by the Office Action); Studiengesellschaft Kohle v. Northern Petrochemical Co., 784 F.2d 351, 355 (Fed. Cir. 1986).

Claim 1 requires that the ornamental figure be "attached" to the bubble wand. Claim 1 of Bitton '017 requires that the ornamental figure be "releasably attached" to the bubble wand. Claim 1 of this application could be literally infringed without infringing claim 1 of Bitton '017. If a device had an ornamental

figure 'fixedly attached' to the bubble wand and otherwise met the claim language, then the device would infringe claim 1 of this application, but not claim 1 of Bitton '017. Thus, according to the rule set forth in Vogel, the double patenting rejection is erroneous and should be withdrawn.

Furthermore, Vogel specifically states that an "invention defined by a claim reciting 'halogen' is not the same as that defined by a claim reciting 'chlorine,' because the former is broader than the latter." Vogel, 422 F.2d at 442. In the case at hand, claim 1 of this application is directed to an ornamental figure "attached" to the bubble wand and claim 1 of Bitton '017 is directed to an ornamental figure "releasably attached" to the bubble wand. Like the example cited in Vogel, claim 1 of this application is broader than claim 1 of Bitton '017. Thus, as in Vogel, claim 1 of this application is not the same invention as claim 1 of Bitton '017. Accordingly, the double patenting rejection is erroneous and should be withdrawn.

Similarly, claim 7 requires that the ornamental figure be "fixedly attached" to the bubble wand. Bitton '017 requires that the ornamental figure be "releasably attached" to the bubble wand. If a device had an ornamental figure 'releasably attached' to a bubble wand and otherwise met the claim language, then the device would infringe claim 1 of Bitton '017 but would not infringe claim 7 of this application. Thus, according to the rule set forth in Vogel, claim 7 of this application is not the same as claim 1 of Bitton '017. Accordingly, the double patenting rejection is erroneous and should be withdrawn.

The Office Action states that claims 6 and 12 are allowable if re-written in independent form. Applicants point out that claims 6 and 12 should also be allowable as dependent from allowable claims 1 and 7, respectively. In addition, claims 2 through 6 and 8 through 11 should also be allowable as dependent from allowable claims 1 and 7, respectively.

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Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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